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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,611

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Ronald Obenhaus

OBEN/0002

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STREETS & STEELE  
13831 NORTHWEST FREEWAY  
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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/734,611	Applicant(s) OBENHAUS, RONALD	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 34-49 is/are rejected.
- 7) ☒ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This is a First Action on the Merits. Claims 1-49 are pending and examined as set forth below.

### *Specification*

1. The disclosure is objected to because of the following informalities: Page 10, paragraph 036, line 7, Applicant refers to support 14 (FIG. 5). Examiner believes Applicant intended (FIG. 6).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, 5, 7 and 19-22 are rejected under 35**

U.S.C. 102(b) as being anticipated by Jones (U.S. Patent No. 5,511,353).

Claim 1: Jones discloses a deck module (Figure 1, element 10) having a base (12) and deck flooring (14), an exposed base

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edge (12, the portion visible by Figure 1 is an exposed edge) and each end of the flooring extends beyond the base (Figure 5, element 16).

Claim 2: the base is rectangular with two base sides (12) and two base ends (12).

Claim 5: the deck flooring (14) is deck flooring boards.

Claim 7: the flooring comprises between two and six flooring boards (Figure 1).

Claims 19 and 20: the deck module is wood (Figure 5).

Claim 21: the means for attaching the flooring is nails.

Claim 22: the overhang (16) of a first deck module covers the base edge (12) of an adjacent deck module.

**Claims 28-31, 34, 39-42, 44-46 and 49** are rejected under 35 U.S.C. 102(b) as being anticipated by Betts (U.S. Patent No. 4,622,792).

Claim 28: Betts discloses a modular deck system with an outer rectangular frame (Figure 1, element 110), with deck modules (102), each module has a base (Figure 3, elements 304, 306, 308) and deck flooring (302) attached to the base with an overhang that extends beyond each end of the base (Figure 3), an exposed base edge (area proximate 304 is exposed), and an end deck module (another module) attachable to opposite ends of the

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frame, and edge of the deck module is attachable to a side of the frame, and an opposite edge of the end deck module is attachable to the exposed base of one or more deck modules.

Claims 29-31: the phrases "positionable...module", Claim 29, lines 1-3, "positionable...module", Claim 30, lines 1-4 and "attachable...frame", Claim 31, lines 1-2 are statements of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 34: the deck flooring is deck flooring boards.

Claims 39 and 40: the module (Claim 39) and flooring (Claim 40) comprise wood.

Claim 41: the flooring is attached to the base by nails.

Claim 42: there are at least two deck modules. The phrase "positionable...module" lines 2-3 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Claim 44: the end deck module (300) comprises deck flooring board (302).

Claim 45: the opposite ends of the frame (Figure 4, elements 414, 418) have a first board (414, 418) and a second board (422, 426) attached to an inner side of the first board.

Claim 46: the first board (414, 418) is wider than the second board (422, 426). See Figure 6.

Claim 49: the outer frame comprises an intermediate support (Figure 6, element 601) attached to an inside face of two sides of the outer frame (603).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8-18, 23-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones.

Claim 8: Jones discloses the claimed invention except that the deck flooring comprises three flooring boards. It would

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have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to make the module in Jones with three flooring boards because Applicant failed to state a criticality for the necessity of only three boards and Jones is capable of being made with three flooring boards.

Claims 9-18: Jones discloses the claimed invention except for the dimensions of the overhang (16, per Claims 9 and 10), the dimensions of the exposed base edge (12, per Claims 11-13), the dimensional relationship between the base edge and the overhang (per Claims 14-16) and the extension of the deck flooring beyond the end of the base (per Claims 17 and 18). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for the necessity of these dimensions and Jones is capable of meeting these limitations.

Claim 23: Jones discloses a deck module (10) having a base (12) and flooring (14) attached to the base. Jones does not disclose the length of the overhang. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for

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the necessity of these dimensions and Jones is capable of meeting these limitations.

Claim 24: the flooring is wood.

Claim 25: the deck flooring is flooring boards.

Claim 27: the flooring is between two and six boards (Figure 1).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Tramill (U.S. Patent No. 1,045,219).

Claims 3 and 4: Jones discloses the claimed invention except for an intermediate support (Claim 3) or that the intermediate support is parallel to the end and attached to an inside face of the base end. Tramill discloses a modular panel (Figure 1) with an intermediate support (8) parallel to the end (2) and attached to the inside face of the base end. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to place an intermediate member as in Tramill to the panel in Jones to increase the structural integrity of the panel.



**Claims 6 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Willis (U.S. Patent No. 5,850,720).

Claims 6 and 26: Jones discloses the claimed invention except that the flooring is made of composite material. Willis has a decking system where the panels are composite (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the panels in Jones out of a composite because a composite results in an overall lighter structure and composite panels can be formed to resemble wood products.

**Claim 35** is rejected under 35 U.S.C. 103(a) as being unpatentable over Betts in view of Willis.

Claim 35: Betts discloses the claimed invention except that the flooring is made of composite material. Willis has a decking system where the panels are composite (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the panels in Betts out of a composite because a composite results in an overall lighter structure and composite panels can be formed to resemble wood products.

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**Claims 36-38 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts.

Claims 36-38: Betts discloses the claimed invention except that the flooring boards comprise between two and six boards (Claim 36), the flooring comprises three deck boards (Claim 37), and the overhang is wider than the exposed edge. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to state a criticality for the necessity of these limitations and the prior art is capable of meeting the limitations as claimed.

Claim 43: Betts discloses the claimed invention except that the overhang of the flooring is between 0.5 inches and about three inches. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to state a criticality for the necessity of these limitations and the prior art is capable of meeting the limitations as claimed.

**Claims 47 and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts in view of Usui (U.S. Patent No. 6,141,927).

Claim 47: Betts discloses the claimed invention except for a third board attached to an outer side of the first board as decoration. Usui discloses a modular system with a third board as decorative facing (Figure 8, element 22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add a decorative facing to the frame in Betts as in Usui for decorative purposes. Further, even though the facing is decorative, it still adds structural support.

Claim 48: Betts in view of Usui does not disclose that the third board (Usui 22) is flooring. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to make the third board facing in order to maintain the aesthetic integrity of the structure.

***Allowable Subject Matter***

4. Claims 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding Claim 32: the prior art of record does not disclose the base as rectangular with two sides attached to two ends. Claim 33 depends from 32.

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dantzer (U.S. Patent No. 6,209,267); Betts (U.S. Patent No. 5,664,381); Beane (U.S. Patent No. 5,617,689); West (U.S. Patent No. 6,314,699).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571.272.6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG

*Daniel Hall*  
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EXAMINER 12/11/86